

REMARKS

By this Amendment and Response to the non-final Office Action mailed on June 13, 2008 ("Office Action"), Claims 1, 2, 9, 11, 12, 19, and 22-25 have been amended, Claims 26-29 have been added, and no claims have been cancelled. Accordingly, Claims 1-29 are presently pending in this Application. Applicants submit that no new matter has been added by these amendments and that support can be found in the Application as originally filed. Applicants also respectfully assert that, as a result of these amendments and the remarks below, the Office Action has been fully responded to and all of the pending claims are now in condition for allowance. Accordingly, Applicants respectfully request reconsideration and allowance of the application.

In addition, Applicants graciously thank Examiner Poinvil for his time and consideration during the telephonic Examiner's Interview with Messrs. Malvern Griffin III and Brian Decker on September 17, 2008 and during the subsequent telephonic conversation on October 7, 2008. As presented herein, Applicants have considered the Examiner's suggestions and have amended the claims accordingly.

Rejections under 35 U.S.C. § 103

In the Office Action, Claims 1-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,884,288 to Chang, et al. ("*Chang*").

Applicants respectfully assert that Claims 1-25 as previously presented are allowable irrespective of the amendments made herein for at least the same reasons as stated in the previous Amendment and Response submitted to the PTO on December 7, 2007. More specifically,

neither *Chang*, nor any other reference of record, alone or in combination, teaches or suggests “determining . . . pre-posting information based at least in part on [a] payment request” and “transmitting . . . to the payee the pre-posting information” prior to directing payment to the payee, as in previously presented independent Claim 1, and similar to previously presented independent Claims 11, 23, 24, and 25. No reference of record teaches or suggests any communication between a service provider and a payee after receiving a payment request from the payee and before directing a payment to the payee, much less transmitting information based at least in part on the payment request prior to directing payment to the payee. Moreover, *Chang* effectively teaches away from determining and transmitting any additional messages because the system of *Chang* is to minimize electronic payment system complexity, (*see Chang*, col. 4, lines 20-25), and is designed to minimize the communications between the payor or payor bank and the payee, (*see, e.g., Chang*, col. 4, lines 52-55, describing the generation of an electronic check envelope to deliver multiple checks to a payee in a single transmission). Thus, determining and transmitting an additional pre-posting message is contrary to the intent of *Chang*. In addition, Applicants state that merely because payment request data may exist at some time with the payor bank of *Chang* does not mean that it would have been obvious to determine pre-posting information based on the payment request and to transmit the pre-posting information to another party (i.e., the payee) for an entirely different purpose, which is not yet taught or suggested, or even contemplated by *Chang* or in any other reference of record. Accordingly, notwithstanding that Applicants have hereby amended the claims, Applicants submit that the claims as previously presented are allowable without amendment.

However, Applicants have amended the claims in an effort to expedite examination as suggested by the Examiner. Accordingly, Applicants respectfully submit that currently pending Claims 1-29, as amended herein, are patentable over *Chang* because *Chang* fails to teach, suggest, or render obvious each feature of the claims as amended.

Chang generally relates to a system for providing automated electronic bill processing capabilities, including an electronic payment system. (*Chang*, Abstract). *Chang* describes a bill payment system where, after receiving a payment authorization from the payor, the payor's bank generates one or more electronic checks, which are then transmitted to the payee. (*Chang*, col. 7, lines 19-34). As described, each payee receives an electronic check envelope that may contain several electronic checks from the same payor bank. (*Chang*, col. 7, lines 35-37). After receiving the electronic check(s) from the payor's bank, the payee processes each electronic check and updates its accounting records accordingly. (*Chang*, col. 7, lines 35-38).

Applicants have amended Claims 1, 9, 11, 19, and 22-25 for further clarification as compared to conventional electronic bill payment systems, such as that described in *Chang* or those described with reference to Figures 1A-1E in the present Application. By example, independent Claim 1, as amended, recites the features of:

constructing, by the payment service provider responsive to receiving the payment request, pre-posting information based at least in part on information extracted from the payment request for notifying the payee of the payment request prior to directing payment to the payee;
transmitting, by the payment service provider to the payee, the pre-posting information

Independent Claims 11, and 23-25 have been similarly amended.

Applicants respectfully assert that *Chang* fails to teach, suggest, or render obvious the features of “constructing, by the payment service provider responsive to receiving the payment request, pre-posting information based at least in part on information extracted from the payment request, wherein the pre-posting information is for notifying the payee of the payment request prior to directing payment to the payee” and “transmitting, by the payment service provider to the payee, the pre-posting information,” as recited in amended Claim 1. More specifically, neither *Chang*, nor any other reference of record, alone or combination, teaches or suggests performing the additional steps of constructing information from a payor’s payment request and communicating that information to a payee prior to directing an actual payment to the payee. *Chang* is similar to conventional electronic bill payment systems, in that the payor bank (in *Chang*, but may be a third party service provider in other systems) transmits a payment directive (in *Chang* it is in the form of an electronic check or an electronic envelope containing multiple electronic checks) to the payee upon receiving payment instructions from a payor. In these conventional electronic bill payment systems no additional information is transmitted to the payee in advance of directing actual payment to the payee, much less information transmitted to notify the payee of the payment request prior to directing payment to the payee.

The Office Action states that “it is noted that the pre-posting information is known and stored in the system of *Chang* . . . [and that] if the pre-posting information is desired to be sent to one or more payees, such would have been readily apparent and/or obvious to do by one of ordinary skill in the art” (Office Action, pg. 4). First, Applicants submit that, in consideration of amended Claim 1, pre-posting information is not known or stored in *Chang*, nor

is it “constructed” based on information “extracted from [a] payment request,” as recited in Claim 1. The Office Action cites Figure 8b of *Chang* as providing pre-posting information, (Office Action, pg. 4); however, Figure 8b merely relates to “a web page [that] can list each of the outstanding bills that are pending payment” that includes “a payment instruction field . . . that allows the payor to indicate the manner in which the payment is to be processed.” (*Chang*, col. 8, lines 61-64). Accordingly, while Figure 8b may relate to a system that allows a payment request be made by a payor, Figure 8b does not at all relate to “constructing . . . pre-posting information based at least in part on information extracted from the payment request, wherein the pre-posting information is for notifying the payee of the payment request prior to directing payment to the payee . . .,” as recited in amended independent Claim 1.

In addition, the Office Action states that it would have been obvious to transmit pre-posting information to one or more payees “with the motivation of acknowledging that the payees are the appropriate recipients of the related payments thereby providing a more secure system.” (Office Action, pg. 4). Applicants respectfully submit, however, that the stated motivation is flawed. The system of *Chang* presents bills that are transmitted from the payees, (*see Chang*, col. 4, lines 37-43); thus, the payor bank is already certain that the payments of the outstanding bills are directed to the correct payee because the bill for which the payment is made is received from the payee. Moreover, Applicants submit that merely having information residing on a system does not render any additional steps of processing, extracting, transmitting, or otherwise using that information obvious. The currently pending claims are directed to solving a problem and providing features that were not yet contemplated, much less obvious, at

the time of the invention – the ability to transmit information associated with a payment to payees prior to issuing actual payment to the payee, such as is described in paragraphs [0068] to [0071] of the present Application.

Accordingly, for at least these reasons, Applicants submit that amended independent Claim 1 is allowable over *Chang* for failing to teach, suggest, or render obvious every feature of the claim. Because the other independent claims include features similar to Claim 1 as described above, Applicants respectfully submit that, for at least the reasons provided for independent Claim 1, amended independent Claims 11, and 23-25 are also allowable over *Chang*.

Furthermore, Applicants respectfully assert that dependent Claims 2-10, 12-22, and 26-29 are patentable as a matter of law, depending from allowable claims, notwithstanding their independent recitation of patentable features.

The Office Action also rejects dependent Claims 10 and 20, stating that “modifying the received payment request would have been obvious to do by one of ordinary skill in the art in order to allow a flexible system.” (Office Action, pg. 5). Applicant respectfully submits that the features of “receiving . . . a payment request change directive to modify the received payment request” and “transmitting . . . information associated with the received payment request change directive that notifies the payee of a change to at least a part of the transmitted pre-posting information,” as recited in dependent Claim 10 for example, are not taught, suggested, or rendered obvious by *Chang* or any other references of record. As described above, because no references even contemplate transmitting a first piece of information in advance of directing a payment to a payee, it necessarily cannot be held that any of the references teach, suggest, or

render obvious “notify[ing] the payee of a change to at least a part of the transmitted pre-posting information,” as recited in dependent Claim 10. Although not addressed specifically in the Office Action, amended independent Claim 23 recites similar features as Claims 10 and 20, which are allowable over *Chang* for at least the same reasons as provided above with regard to independent Claim 1 and here with regard to dependent Claim 10.

Accordingly, Applicants additionally submit that independent Claim 23 and dependent Claims 10 and 20 are allowable for at least these additional reasons.

Allowability of New Dependent Claims

Although Applicants respectfully assert that dependent Claims 26-29 are patentable as a matter of law, depending from allowable claims, additional reasons of patentability for at least some of newly presented dependent Claims 26-29 are provided.

With reference to new dependent Claims 26 and 28, Applicants respectfully submit that neither *Chang*, nor any other reference of record, teaches, suggests, or renders obvious the feature of “determining . . . that the payee is to receive pre-posting information” As described above, no references even contemplate transmitting information in advance of directing a payment to a payee; therefore, the references necessarily do not teach or suggest determining whether the payee is to receive pre-posting information, as recited in dependent Claims 26 and 29.

Similarly, because none of the references of record teach, suggest, or render obvious constructing pre-posting information, the references necessarily do not teach or suggest

extracting information from a payment request to construct pre-posting information, as recited in new dependent Claims 27 and 29.

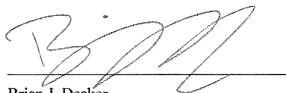
Accordingly, for at least these additional reasons, newly presented dependent Claims 26-29 are allowable over the references of record.

CONCLUSION

Reconsideration of the Application is requested in light of the amended claims and the remarks. Applicants believe they have responded to each matter raised in the Office Action. Allowance of the claims is respectfully solicited. It is not believed that any extensions of time or additional fees are required beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

If there are any issues which can be resolved by teleconference call or an Examiner's Amendment, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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